

1  
2 Mail Stop Interference  
3 P.O. Box 1450  
4 Alexandria Va 22313-1450  
5 Tel: 571-272-4683  
6 Fax: 571-273-0042  
7

Paper 23  
Filed: September 28, 2010

8 UNITED STATES PATENT AND TRADEMARK OFFICE

10  
11  
12 BEFORE THE BOARD OF PATENT APPEALS  
13 AND INTERFERENCES  
14

15  
16  
17 SUNING WANG and RUIYAO WANG  
18 Junior Party  
19 (U.S. Application 10/825,685),  
20

21 v.  
22

23 HANY AZIZ, GEORGE VAMVOUNIS, NAN-XING HU,  
24 ZORAN D. POPOVIC, AND JENNIFER A. COGGAN  
25 Junior Party  
26 (U.S. Patent 7,291,404).  
27

28  
29  
30 Patent Interference No. 105,691 (MPT)  
31 (Technology Center 1700)  
32

33  
34  
35 MEMORANDUM OPINION and ORDER  
36 Decision on Motions  
37

38 Before: SALLY G. LANE and SALLY C. MEDLEY and MICHAEL P. TIERNEY,  
39 *Administrative Patent Judges.*  
40

41 TIERNEY, *Administrative Patent Judge.*

1 This interference is before a motions panel for a decision on preliminary  
2 motions.

3  
4 I. Introduction

5 This interference is directed to photoluminescent and electroluminescent  
6 azole compounds and electroluminescent devices employing such compounds.

7 Both Aziz and Wang have been designated junior party as the parties  
8 coordinated the filing of provisional patent applications such that they would be  
9 filed on the same day.<sup>1</sup> 37 C.F.R. § 41.201. Specifically, Aziz's involved '404  
10 patent and Wang's involved '685 application have the same constructive reduction  
11 to practice date based on provisional applications filed April 17, 2003. The  
12 provisional applications and subsequent patent applications however, cited  
13 different inventive entities and different assignees. (*Id.*). Aziz and Wang are now  
14 commonly assigned to LG Display.

15 There are three (3) pending preliminary motions awaiting decision. The  
16 motions were filed jointly by Wang and Aziz, hereinafter "Wang." Wang  
17 Motion 1 requests judgment for no interference-in-fact, Wang Motion 2 moves to  
18 redefine the count and Wang Contingent Motion 3 requests that Aziz claims 2, 23  
19 and 24 be designated as not corresponding to Count 1.

20 We deny Wang Motion 1 as we hold that Wang has failed to meet its burden  
21 of proof that there is no interference-in-fact between the parties' claims. We  
22 likewise deny Wang Motion 2 to substitute a count and deny Wang Motion 3 as

---

<sup>1</sup> Wang, during prosecution of its '685 application informed the Examiner that Aziz and Wang had worked together and decided that each of them would file a patent application on the same day. (Wang '685, Amendment filed August 11, 2008, pgs. 10-11).

1 Wang has failed to demonstrate that Aziz claims 2, 23 and 24 should not be  
2 designated as corresponding to Count 1.

3  
4 II. Findings of Fact

5 A. The Real Party in Interest

6 1) LG Display Co. Ltd. is the real party in interest for Aziz. (Order, July 24,  
7 2009, Paper 5, p. 2).

8  
9 2) At the time the interference was declared Queen's University of Kingston,  
10 Canada, was the real party in interest in Wang's involved '685 application.  
11 (Paper 3). After the interference was declared, Wang's '685 application was  
12 assigned to LG Display Co., Ltd., which is the real party in interest for Aziz. (*Id.*).

13  
14 B. Priority of Invention

15 3) Aziz is involved in the interference based on U.S. Patent 7,291,404, issued  
16 on November 6, 2007, based on U.S. Application 10/702,859, filed November 6,  
17 2003. (Declaration, Paper 1, p. 3).

18  
19 4) Wang is involved in the interference based on U.S. Application 10/825,685,  
20 filed April 16, 2004. (Declaration, Paper 1, p. 3).

21  
22 5) Wang and Aziz both filed provisional applications, Wang: 60/463,337 and  
23 Aziz: 60/463,312, on April 17, 2003. (Declaration, Paper 1, pp. 4-5). The parties  
24 decided to file their provisional applications on the same day so that the  
25 applications would not be citable against each other. (Wang Exhibit 2003, '685  
26 Amendment filed August 11, 2008, pp.10-11).

1  
2 6) As to Count 1, the parties have agreed that Wang has priority over Aziz.  
3 (Joint Priority Statement, Paper 13).

4  
5 C. Count/claim correspondence

6 7) There is a single count in the interference, Count 1, which concerns claim 5 -  
7 of Wang, U.S. Application 10/825,685 and claim 41 of Aziz, U.S. Patent No.  
8 7,291,404.

9  
10 8) Claim 5 of Wang is directed to a photo/electroluminescent azole compound.  
11 Claim 41 of Aziz overlaps in scope and claims a photo/electroluminescent azole  
12 compound used in an electroluminescent device, specifically an organic light  
13 emitting device (OLED).

14  
15 9) The claims of the parties are:

16 Wang '685 Application: 2, 5-14, 17-22, 40-47 and 49-52

17 Aziz '404 Patent: 1-62

18  
19 10) The claims of the parties which correspond to Count 1 are:

20 Wang '685 Application: 2, 5-14, 17-22, 40-47 and 49-52

21 Aziz '404 Patent: 1-62

22  
23 11) The claims of the parties which do not correspond to Count 1, and therefore  
24 are not involved in this interference, are:

25 None.

1 D. One of ordinary skill in the art

2 12) The relevant art is that of organic light emitting devices (OLEDs).

3  
4 13) A person of ordinary skill in the OLED art would have at least a bachelors  
5 degree in chemistry, materials science, or other related field of study and some  
6 work experience. (Wang Exhibit (“WX”) 2001, Declaration of Jungkeun Kim,  
7 ¶ 6).

8  
9 14) Wang states that one of ordinary skill in the art would have knowledge of  
10 the types of materials known and used in OLEDs and the basic structure and  
11 design considerations. (Paper 14, Wang Motion 1 at 7).

12  
13 15) Dr. Kim testifies on behalf of Wang and is sufficiently qualified to give  
14 testimony with respect to the particular facts known by one of ordinary skill in the  
15 art in the field of OLEDs. (WX 2001, ¶¶ 1-3).

16  
17 16) Dr. Kim testifies that one skilled in the art understood that OLEDs typically  
18 include an array of pixels having an luminescent material between two electrodes  
19 (anode and cathode). When an electrical signal is applied to the electrodes, the  
20 luminescent material produces light. (WX 2001, ¶ 15).

21  
22 17) Dr. Kim also testifies that one skilled in the art understood that the  
23 performance of an OLED may be improved by adding a layer charge injection and  
24 transport layer between the electrodes and the luminescent material. (*Id.* at ¶ 17).

25  
26 18) Dr. Kim testifies that Wang’s invention is directed to a novel organic azole

1 compound for use as an emitter in OLEDs whereas Aziz's invention is directed to  
2 an OLED using a novel organic azole compound as an electron injection and  
3 transport material. (*Id.* at ¶¶ 11 and 13).

4  
5 19) Dr. Kim states that Wang and Aziz's claimed azole compounds are similar,  
6 albeit not identical. (*Id.* at ¶ 25).

7  
8 20) In discussing the additional substituents present in Aziz's azole compounds,  
9 Dr. Kim testifies that "the addition of substituents to a chemical compound is  
10 unpredictable." (*Id.* at ¶ 35).

11  
12 21) Dr. Kim testifies that a paper authored by all of the inventors of the Wang  
13 application and Aziz patent ("Wang paper," WX 2004) describes a specific azole  
14 compound. (WX 2001, ¶ 30). According to Dr. Kim, the paper demonstrates that  
15 a specific azole compound ("compound 1") performed comparably or better than  
16 an industry standard electron-transport compound, Alq<sub>3</sub>. (*Id.* at ¶ 31).

### 17 18 III. Opinion

19 There are three (3) pending motions awaiting decision. Although the  
20 motions are unopposed, a party filing a motion has the burden of establishing that  
21 it is entitled to the relief requested. 37 C.F.R. § 41.208, *see also*, *Pechiney*  
22 *Emballage Flexible Eur. v. Cryovac Inc.*, 73 USPQ2d 1571, 1573 (Bd. Pat. App. &  
23 Int., 2004). Accordingly, Wang, as the moving party, has the burden of proof with  
24 respect to its substantive motions. The evidentiary standard for Wang's motions is  
25 preponderance of the evidence. *Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1120 (Fed.  
26 2004). The burden of showing something by a preponderance of the evidence

1 simply requires the trier of fact to believe that the existence of a fact is more  
2 probable than its nonexistence before the trier of fact may find in favor of the party  
3 who carries the burden. *Concrete Pipe & Products of California, Inc. v.*  
4 *Construction Laborers Pension Trust for Southern California*, 508 U.S. 602, 622  
5 (1993). (citation omitted).

6  
7 A. Wang Motion 1 for No Interference-in-fact

8 Wang Motion 1 alleges that there is no interference-in-fact between Wang's  
9 azole compound claims and Aziz's OLED having a transporting layer comprising  
10 an azole compound. (Paper 14, 6:3-13). Specifically, Wang states that the  
11 invention claimed by Wang does not anticipate or render obvious Aziz's claimed  
12 invention. (*Id.*, 3:31-32). Wang does however state that its analysis assumes that  
13 certain Wang and Aziz claims are cancelled. (*Id.* at 2:8-10).<sup>2</sup>

14  
15 1. Legal Principles

16 An interference-in-fact exists when an application and a patent or an  
17 application and another application each have at least one claim directed to  
18 patentably indistinct subject matter. The existence of an interference-in-fact is  
19 initially determined by applying the so called "two-way test" of 37 C.F.R.  
20 § 41.203(a)(2004):

21 An interference exists if the subject matter of a claim of one party  
22 would, if prior art, have anticipated or rendered obvious the subject  
23 matter of a claim of the opposing party and vice versa.

24  
25 Thus, the subject matter of a claim of one party is assumed to be prior art

---

<sup>2</sup> Wang Motion 1 requests leave to cancel Wang claims 13, 14, 17, 18, 46, 47, 49  
and 50 and Aziz claims 59 and 60. (Paper 14, 3:33 – 4:2).

1 with respect to the claimed subject matter of the opponent. An evaluation is made  
2 to determine if the opponent's claimed subject matter is anticipated by or obvious  
3 from the subject matter of the other party's claims. The analysis is then repeated  
4 with the opponent's claimed subject matter assumed to be prior art. No  
5 interference-in-fact is shown if the outcome of either evaluation is that one party's  
6 claims is neither anticipated nor obvious from the other party's claims.

7 Anticipation is established only when a single prior art reference discloses  
8 all elements of the claimed invention. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir.  
9 1990). Regarding obviousness, the U.S. Supreme Court has stated:

10 "Under § 103, the scope and content of the prior art are to be  
11 determined; differences between the prior art and the claims at issue  
12 are to be ascertained; and the level of ordinary skill in the pertinent art  
13 resolved. Against this background the obviousness or nonobviousness  
14 of the subject matter is determined. Such secondary considerations as  
15 commercial success, long felt but unsolved needs, failure of others,  
16 etc., might be utilized to give light to the circumstances surrounding  
17 the origin of the subject matter sought to be patented."

18  
19 *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). Thus, the  
20 evaluation of obviousness, or non obviousness, requires consideration of the scope  
21 and content of the prior art and level of ordinary skill in the art. The obviousness  
22 conclusion is reached from the perspective of the hypothetical person having  
23 ordinary skill in the art. That person is presumed to be aware of all the pertinent  
24 prior art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454 (Fed.  
25 Cir. 1985).

26 In more typical situations involving obviousness, such as ex parte  
27 examination or a civil action for patent infringement, a party asserts that the  
28 claimed subject matter would have been obvious. Yet, the situation in a motion for  
29 no interference-in-fact or a motion to undesignate claims is the opposite. The



1 analysis starts with the presumption that the claimed subject matter would have  
2 been obvious from the count subject matter. The moving party bears the burden of  
3 establishing a negative – that the subject of the claims would not have been  
4 obvious.

## 5 6 2. Analysis

### 7 a. Wang Claims Do Not Anticipate Aziz's Claims

8 Aziz claims an electroluminescent device and a photo/electroluminescent  
9 azole compound for use in that device. (Aziz Clean Copy of Claims, Paper 7,  
10 claim 41). Wang claims a photo/electroluminescent azole compound and a method  
11 of synthesizing it. (Wang Clean Copy of Claims, Paper 8, claims 5, 51). As Aziz  
12 claims all elements present in Wang's claims, Aziz's claims anticipate Wang's  
13 claims. Conversely, Aziz claims the azole compound in combination with several  
14 other elements not included in Wang's claims. For example, Aziz requires a  
15 device comprising an anode, cathode, buffer layer, and luminescent region  
16 containing an electron injection and transporting zone and a mixed charge transport  
17 layer. Wang's claims do not expressly or inherently require these additional device  
18 features. Therefore Wang's claims cannot anticipate Aziz's claims.

19 The two-way test requires that both claimed inventions, when treated as  
20 prior art, anticipate *or* render obvious the other in order for an interference-in-fact  
21 to exist. Wang's claims does not anticipate Aziz's claims, so our inquiry turns to  
22 the question of obviousness.

1                   b.     Aziz's Claimed Invention Combines Known  
2                   Luminescent/OLED Elements for their Known Purpose  
3

4           Anticipation is the epitome of obviousness; as such Aziz renders Wang  
5 obvious. *See Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir.  
6 1983). Thus, as recognized by Wang, the issue presented by Wang's Motion is:

7           Specifically, would one of skill in the art have found it obvious to  
8 combine the azole compound of the Wang claims with an OLED  
9 including an anode and a cathode and to use the azole compound of  
10 the Wang claims as an electron injection and transporting material in a  
11 luminescent region as claimed in the Aziz claims?  
12

13 (Paper 14, 6:16-19).

14 For the following reasons, we hold that Wang has failed to demonstrate by a  
15 preponderance of the evidence that Aziz claims patentably distinct subject matter  
16 such that there is no interference-in-fact between the parties.

17       Wang contends that, because the claimed azole compound of Wang was  
18 novel, one of ordinary skill in the art would "not know of any applications of this  
19 compound other than those disclosed in Wang." (Paper 14, 7:9-11). Wang states  
20 that Wang's specification does not indicate that its claimed azole compound would  
21 be used as a charge material. (*Id.*, 7:12-18). Wang further contends that Wang's  
22 specification teaches away from using the azole compound as a charge transport  
23 material because Wang uses a conventional electron transport material for the  
24 electron transport layer. (*Id.*, 7:19-23). These arguments are misplaced.

25       The question raised by Wang Motion 1 is whether Aziz's claims are  
26 rendered obvious or anticipated in light of Wang's claimed invention assuming that  
27 Wang's claimed invention is available as §102(g) prior art to Aziz. As such, the  
28 test for interference-in-fact focuses solely on the claims; therefore the obviousness

1 analysis does not consider information in the specification except for the purpose  
2 of providing context and explanation for the claims. *Noelle v. Lederman*, 355 F.3d  
3 1343, 1347 (Fed. Cir. 2004)(Suggestion and reasonable expectation of success  
4 must be found in the prior art not in applicant's disclosure).

5 The differences between Wang and Aziz's claims are that Wang claims the  
6 compound and method of producing the compound, while Aziz claims the  
7 compound plus the structure for use in an OLED device. As to the inclusion of  
8 Wang's azole compound in an OLED, Wang claim 2 requires Wang's azole  
9 compound to be "photoluminescent or electroluminescent." (Paper 8, claim 2).  
10 Thus, Wang provides a specific reason to employ its claimed azole compound in  
11 photoluminescent and/or electroluminescent devices. Further, as to Aziz's claimed  
12 OLED structure, Dr. Kim acknowledged that OLEDs were known in the art as  
13 having anodes and cathodes with charge injection and transport layers for use with  
14 luminescent material. (WX 2001, ¶¶ 15-17). Thus, there is reason to believe that  
15 Aziz's invention merely combines Wang's luminescent azole compound with an  
16 art recognized OLED structure for their known luminescent function to achieve a  
17 predictable result.

18 Wang contends that "unexpected benefits" are obtained from Aziz's use of  
19 the azole compound in the OLED structure. (Paper 14, 8:1-3). Wang's secondary  
20 consideration contention is discussed below.

21  
22 c. Wang Has Failed to Demonstrate Unexpected Results for  
23 Aziz's Claimed OLED  
24

25 Wang contends that unexpected benefits are obtained from using the azole  
26 compound of Wang as an electron transport material, such as Aziz has done.  
27 (Paper 14, 8:1-3). As evidence of unexpected results, Wang relies upon both

1 Aziz's specification and a journal article by Wang *et al.* which provide test results  
2 for an azole compound<sup>3</sup> that falls within the claimed genus. (Paper 14, 8:4-9:14).  
3 According to Dr. Kim, the tested azole was shown to have outperformed the  
4 industry standard, Alq<sub>3</sub>, and that the improved performance would have been  
5 significant to one skilled in the art. (WX 2001, ¶ 31).

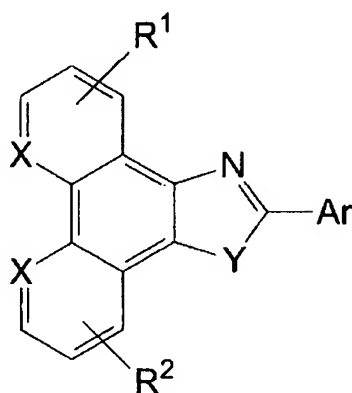
6 A presumption of obviousness may be rebutted by a demonstration of  
7 unexpected results. *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995). These are  
8 results that demonstrate the claimed invention exhibits a superior property or  
9 advantage that a person of ordinary skill in the art would find surprising or  
10 unexpected. *Id.* The party alleging nonobviousness must present factual evidence  
11 of unexpected results; mere conclusory statements that the results are surprising are  
12 insufficient. *Id.* The results must also be commensurate in scope with the claimed  
13 invention. *In re Peterson*, 315 F.3d 1325, 1330-31 (Fed. Cir. 2003), *see also In re*  
14 *Dill*, 604 F.2d 1356, 1361 (CCPA 1979) (certain limitations of the claimed  
15 invention were tested and yielded unexpected results, but the claim was drawn to a  
16 much broader genus; the court held the results were not commensurate with the  
17 scope of the claims).

18 Wang's demonstration of unexpected results is insufficient as the testing was  
19 not commensurate in scope with the claimed invention. Specifically, Aziz's  
20 claim 1 recites an electron injection and transporting zone having an azole  
21 compound selected from a large genus of azole compounds of formula (1)  
22 reproduced below:

23  

---

<sup>3</sup> The compound tested was 1-Methyl-2-(anthryl)-imidazo[4,5-f][1,10]-phenanthroline. (Wang Paper, WX 2004, title and Aziz Spec., WX 2002, 10-15)



(I)

wherein one X represents N and the other X represents CH or N;

Y is an atom or a group selected from the group consisting of O, S, and -N(R)-, wherein R is a hydrocarbyl group of from 1 to about 30 carbons;

R<sup>1</sup> and R<sup>2</sup> are each a substituent selected from the group consisting of hydrogen, an alkyl group of from 1 to about 25 carbon atoms, an aryl group of about 6 to about 30 carbon atoms, an alkoxy group of from 1 to about 25 carbon atoms, a halogen, and a cyano group; and

Ar is an aromatic component.

(Aziz Clean Copy of Claims, Paper 7). As is apparent from Aziz claim 1, Aziz's claimed genus of azole compounds is exceedingly large. For example, the azole compound of formula I requires a substituent Ar, which is loosely defined as "an aromatic component." Aziz's specification generally defines its aromatic component as follows:

Ar is an aromatic component, such as an aryl group having, for example, from about 6 to about 30 carbons. Illustrative examples of aryl group for Ar can be selected from the group consisting of a phenyl, a naphthyl, an anthryl and the like. The aromatic component for Ar may be a heteroaryl group of for example, a pyridyl, and a

1       quinolyl, and the like.  
2  
3       (WE 2002, 8:3-9).

4       Neither Dr. Kim, the Wang paper or Aziz's specification provides a  
5       credible basis to conclude that the single azole compound tested was  
6       sufficiently representative of Aziz's claimed genus of azole compounds for  
7       an electron injection and transporting zone. Specifically, Wang fails to  
8       provide credible and sufficient evidence to demonstrate that the sole azole  
9       compound tested behaves in the same or similar manner to the genus of  
10      azole compounds falling within the scope of Aziz's claims.

11      Wang has failed to meet its burden of demonstrating that they are entitled to  
12      a finding of no interference-in-fact as they have not shown that Aziz and Wang are  
13      drawn to patentably distinct subject matter. Wang Motion 1 is *denied*.

14  
15      B.     Wang Motion 2 to Substitute Counts

16      Wang moves to redefine the count by substituting two new counts, Counts 2  
17      and 3, for Count 1. (Paper 15, 2:1-10). Wang states that, upon grant of Motion 2,  
18      certain Wang and Aziz claims are to be cancelled. (*Id.* at 2:11-14).<sup>4</sup>

19      A party moving to substitute a count has the burden of proving that it is  
20      entitled to the relief requested. 37 C.F.R. § 41.121(b). As part of its procedural  
21      burden, a party must i) propose a new count, ii) show why the count is patentably  
22      distinct from every other count the movant believes should remain, iii) show why  
23      the parties' claims do or do not correspond to the proposed count and iv) show why  
24      the movant should be accorded any benefit for the proposed count. (Standing

---

<sup>4</sup> Wang Motion 2 contingently requests leave to cancel Wang claims 13, 14, 17, 18, 46, 47, 49 and 50 and Aziz claims 59 and 60. (Paper 14, 3:33 – 4:2).

1 Order, Paper 2, ¶ 208.2).

2 Wang contends that Count 1 should be replaced with new proposed Counts 2  
3 and 3 as the present count is directed to Wang claim 5 and Aziz claim 41, two  
4 claims which Wang alleges do not interfere-in-fact. (Paper 15, 3:8-11). Wang  
5 summarizes its contentions regarding the need for new counts as follows:

6  
7 C. Two New Counts 2 and 3 Should Replace Count 1

8  
9 As discussed above the claims of Count 1 do not interfere.  
10 Hence, Wang and Aziz propose two new counts. Count 2 is defined  
11 as claim 5 of Wang and claim 59 of Aziz. Count 3 is defined as claim  
12 13 of Wang and claim 41 of Aziz. In Count 2 the two claims  
13 identified are both compound claims that have interfering subject  
14 matter. In Count 3 the two claims identified are both devices using an  
15 azole compound that have interfering subject matter.  
16  
17 (Paper 15, 8:18-9:2).

18 Wang Motion 2 contends that there is no interference-in-fact for reasons that  
19 are discussed above with respect to Wang Motion 1. As we have denied Wang's  
20 request for judgment of no interference-in-fact, we likewise deny Wang Motion 2  
21 to substitute counts, as Wang Motion 2 is predicated on no interference-in-fact  
22 between Wang claim 5 and Aziz claim 41.

23 Additionally, we deny Wang Motion 2 for failure to comply with the  
24 procedural requirements for adding or substituting counts. For example, Wang  
25 Motion 2 does not identify its claims that do or do not correspond to the proposed  
26 counts or whether Wang/Aziz should be accorded benefit for the proposed counts.

27 Wang Motion 2 to redefine the interfering subject matter by substituting  
28 counts is *denied*.

1 C. Wang Motion 3 to Undesignate Claims

2 Wang Motion 3 requests that Aziz dependent claims 2, 23 and 24 be  
3 designated as not corresponding to Count 1. (Paper 16, 2:1-3). This motion is  
4 contingent on the denial of Wang Motion 1 for no interference-in-fact. (*Id.*, 2:6-7).  
5 According to Wang, Aziz claims 2, 23 and 24 are patentably distinct from the  
6 claims of Wang and therefore do not correspond to the count. (*Id.*, 2:9-14).

7  
8 1. Legal Principles

9 A claim corresponds to the count when it is patentably indistinct from the  
10 subject matter of the count. In other words, a “claim corresponds to a count if the  
11 subject matter of the count, treated as prior art to the claim, would have anticipated  
12 or rendered obvious the subject matter of the claim.” 37 C.F.R. § 41.207(b)(2). In  
13 concept, claim correspondence analysis is similar to the analysis involved with  
14 “one-way” obviousness-type double patenting. However, the count rather than a  
15 claim is used as the presumed prior art in evaluating patentable distinctness of the  
16 parties’ claims.

17 Wang contends that the Standing Order § 208.3.2 requires that claim  
18 correspondence be determined by comparing the parties’ claims. Contrary to  
19 Wang’s contention, both the rules and the Standing Order provide that claim  
20 correspondence is determined via a count based analysis. A comparison of  
21 Standing Order § 208.3.2 and Wang’s contention is provided below:



1

Standing Order § 208.3.2	Wang's Contention
<p>A motion to have a claim designated as not corresponding to a count <i>must show why the subject matter of the count</i>, if treated as prior art, would not have anticipated or rendered obvious the subject matter of the claim. Bd.R. 207(b)(2).</p> <p>A movant may not seek to have all of a party's claims designated as not corresponding to the count. Instead, such relief should be sought by way of a motion for judgment of no interference-in-fact.</p>	<p>A party may move to designate claims as not corresponding to a count when the designated claims are not anticipated nor rendered obvious by from the claims corresponding to the count. SO ¶ 208.3.2. So in the present case, it <i>must be shown that claims 2, 23, and 24 of Aziz are patentably distinct from the claims of Wang</i>.</p>

2

3 As shown by the above comparison, the Standing Order requires that claim  
4 correspondence is a count based analysis as opposed to Wang's alleged claim  
5 versus claim analysis. Further, Wang's mere statement that an Aziz v. Wang claim  
6 based analysis should be made is insufficient to show that an exception be made to  
7 the rules and Standing Order. We hold that, consistent with the rules and Standing  
8 Order, the proper comparison for claim correspondence is whether the count, taken  
9 as prior art, anticipates or renders obvious the subject matter of a claim.

10

11 2. Wang Fails to Meet its Burden to Demonstrate that Aziz's  
12 Claims 2, 23 and 24 are Unobvious over Count 1

13

14 Wang, as the moving party, has the burden of establishing that it is entitled  
15 to the relief requested. 37 C.F.R. § 41.208. As part of its burden, Wang contends  
16 that Aziz claims 2, 23 and 24 are unobvious over any claims of Wang. (Paper 16,  
17 2:17-18). In particular, Wang contends that Aziz claims 2, 23 and 24 require the

1 presence of substituents that are not present in any of Wang's claims. (*Id.*, 2:15 –  
2 3:15). Wang states that the additional substituents would not have been obvious  
3 "because the addition of substituents to a chemical compound is unpredictable."  
4 (*Id.*, 2:22-23, 3:4-6 and 3:10-13).

5 Count 1 is defined as the union of Wang claim 5 and Aziz claim 41. Aziz  
6 claim 41 encompasses the subject matter of Aziz claims 2, 23 and 24.  
7 Accordingly, the question before us is whether it would have been obvious to one  
8 of ordinary skill in the art to select the substituents in question from Aziz claim 41.

9 It was Wang's burden to provide evidence relating to the scope and content  
10 of prior art so that we may determine whether the selection of the specifically  
11 claimed substituents would have been obvious *Graham*, 383 U.S. at 17-18, *see*  
12 *also Pechiney*, 73 U.S.P.Q.2d at 1573 (Bd. Pat. App. & Int. 2004). Specifically,  
13 Wang must show that Aziz claims 2, 23 and 24 are nonobvious in light of Aziz  
14 claim 41 and the entire scope of prior art pertaining to luminescent compounds  
15 generally and/or OLED structures. Wang however, has not directed our attention  
16 to evidence on the scope and content of the prior art. For example, Dr. Kim's  
17 testimony does not discuss any prior art. Wang has also failed to present sufficient  
18 and credible evidence that a person of ordinary skill in the art would not have  
19 found it obvious, in light of the structure of Aziz claim 41, to select the appropriate  
20 substituents. Accordingly, we hold that Wang has failed to meet its burden of  
21 proof with respect to Wang Motion 3 and demonstrate that the count does not  
22 anticipate or render obvious Aziz claims 2, 23 and 24.

23 Additionally, Wang fails to meet its burden of proof even if Wang were  
24 correct and claim correspondence allowed for a comparison between Wang's  
25 claims and Aziz's claims. Specifically, Wang states that Aziz's claims recite  
26 substituents that are not present on Wang's claimedazole compounds. Wang relies

1 upon the testimony of Dr. Kim to establish that the “addition of substituents to a  
2 chemical compound is unpredictable.” (WX 2001, ¶ 35). Dr. Kim however, does  
3 not explain the underlying basis for this broad proposition and we do not credit his  
4 conclusion for the reasons provided below. *Rohm & Haas Co. v. Brotech Corp.*,  
5 127 F.3d 1089, 1092 (Fed. Cir. 1997)(Nothing in the rules or in jurisprudence  
6 requires trier of fact to credit unsupported or conclusory assertions).

7       The addition of a substituent to a chemical compound can, depending on the  
8 specific chemical field in question, be unpredictable. The question is whether or  
9 not the addition of the particularly claimed substituents to an electroluminescent  
10 azole compound was unpredictable in the OLED art. As discussed above, Wang  
11 has not provided a sufficient explanation as to the scope and content of the prior  
12 art. Lacking such an explanation of the art in question we decline to credit Dr.  
13 Kim’s conclusory testimony that the addition of substituents to a chemical  
14 compound is unpredictable.

15       Additionally, Aziz’s own claims allow for a substituent identified as Ar,  
16 which is loosely defined as “an aromatic component.” *See, e.g.*, Aziz claim 41.  
17 Such a general definition would, on its face, allow for the presence of an aromatic  
18 ring structure having an untold number of substituents added to it. We find it  
19 difficult to credit Dr. Kim’s testimony that the addition of substituents to a  
20 compound was unpredictable given that Aziz’s claimed azole compound allows for  
21 an undefined number of additional substituents. While it may be possible to  
22 reconcile the apparent inconsistency between Dr. Kim’s testimony and Aziz’s  
23 claimed compound structure, it was Wang’s burden, not the Board’s to reconcile  
24 the inconsistency.

25       We deny Wang Motion 3.

1 IV. Conclusion

2 Wang Motions 1-3 have been denied. An interference-in-fact exists between  
3 Wang and Aziz's claimed subject matter. The parties have agreed that Wang has  
4 priority over Aziz for the subject matter of Count 1. (Joint Priority Statement,  
5 Paper 13). Concurrent with this decision the Board enters judgment on priority of  
6 invention for Count 1 against Aziz.

7  
8 V. Order

9 Based upon the evidence identified in the record, it is:

10 **ORDERED** that Wang Motion 1, which requests judgment of no  
11 interference-in-fact, is *denied*.

12 **FURTHER ORDERED** that Wang Motion 2, which seeks to  
13 redefine the interference by substituting new proposed Counts 2 and 3, is *denied*.

14 **FURTHER ORDERED** that Wang Motion 3, which seeks to  
15 undesignate Aziz claims 2, 23 and 24, is *denied*.

16  
17  
18 cc (via electronic filing):

19 Counsel for Wang and Aziz:

20 Song K. Jung, Esq.  
21 Matthew T. Bailey, Esq.  
22 McKENNA LONG & ALDRIDGE LLP  
23 1900 K Street, N.W.  
24 Washington, D.C. 20006  
25 Tel: 202-496-7500  
26 Email: [mlaip@mckennalong.com](mailto:mlaip@mckennalong.com)  
27  
28